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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,099	12/11/2000	Johannes Dapprich	22650-001 CIP	5343

30623 7590 05/06/2003

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EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/735,099

Applicant(s)

DAPPRICH ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3-19 21.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

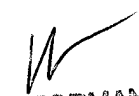
Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues limitations not claimed. Specifically, Applicant argues that the claims require isolating and detecting a starting nucleic acid. While this argument was addressed in the previous Advisory Action, the argument will be addressed again. The claims are drawn to a method of separating a nucleic acid of interest.....the method steps include providing a population of nucleic acid molecules comprising at least one nucleic acid SEQUENCE of interest and further recite immobilizing..... the at least one nucleic acid SEQUENCE of interest..... As such, the claims are limited to separating a SEQUENCE of interest. The claims are not limited to separating and detecting the nucleic acid molecule as present in the starting population as Applicant repeatedly argues. In contrast, the claims are broadly drawn to a method "comprising" immobilizing "at least one nucleic acid sequence".

Applicant argues that the because the claims require separating and detecting a nucleic acid present in the starting population, the claim cannot encompass an additional step of amplification as taught by Whitcombe. The argument has been considered but is not found persuasive for the reasons stated above i.e. the claims are not limited to separating and detecting a nucleic acid present in the starting population.

Regarding the Lundeborg reference, Applicant argues that the term "conditional" cannot be interpreted as the examiner has interpreted it because in the context of the claim "conditional" means "something indispensable to the appearance of occurrence of something else" (The American Heritage Dictionary of the English Language) which excludes a situation in which the occurrence of second event is merely improved or enhanced by the occurrence of a first event. The argument has been considered but is not found persuasive because (using the definition provided by Applicant) the improved and/or enhanced attachment of Lundeborg is conditional on the presence of the distinguishing element. Furthermore, the claims do not recite limitations wherein the attachment of the separation groups is indispensable to the presence of the bound targeting element and distinguishing element in the vicinity of the bound targeting element. As such, Applicant's arguments are not commensurate in scope with the rejected claims.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

BJ Forman, Ph.D.
Art Unit: 1634
5 May 2003


B. J. FORMAN
PATENT EXAMINER